

REMARKS

This Response is submitted in reply to the Final Office Action dated February 12, 2007. Claim 21 stands cancelled without prejudice or disclaimer.

In a telephone conversation the week of April 9, 2007, Supervising Primary Examiner Pezzuto indicated that the finality of this Office Action would be withdrawn. Accordingly, Applicants are treating this Office Action as a Non-Final Office Action. If this Office Action remains a Final Office Action, Applicants respectfully request the Examiner to contact the undersigned such that a proper Request for Continued Examination may be submitted. No fees are due in connection with this Response, however please charge deposit account number 02-1818 for any fees associated with filing this Response.

The Examiner has still not initialed that he considered EP 0926645 on the PTO Form 1449 considered by the Examiner on January 7, 2006. Applicants respectfully request the Examiner to consider this reference in connection with this application. Applicants submit another copy of this reference herewith for the Examiner's convenience.

The Office Action rejected Claims 1 to 13, 15 to 29, 31 to 41, 43 to 50, 52 to 62 and 64 to 78 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,312,334 to Yoseloff in view of Let's Make a Deal – Wikipedia ("LMD") and in further view of U.S. Patent Application Publication No. 2002/0042294 to Pau et al. ("Pau"). Applicants respectfully disagree and traverse these rejections for at least the following reasons.

Yoseloff discloses a gaming device that entices players to risk an initial award in return for the opportunity to receive a greater payoff in a second game segment during which a player chooses from several masked awards. For example, the player risks prizes obtained from a first game or event in the second game or the second event. In the second game, a player selects one of three doors to receive a prize, a neutral event (e.g., a push, loss of a percentage of the wager, gain of a small percentage of the wager, etc.) or a doubling or otherwise substantial increase in the wager award. The outcome associated with the selected door is provided to the player. Yoseloff does not

disclose a first potential award offer formed from a first quantity of first values (wherein the first quantity is greater than one) and a second potential award offer formed from a second quantity of second values. Moreover, Yoseloff does not disclose that the first quantity is, on average, greater than the second quantity, and the second values are, on average, greater than the first values.

LMD provides a description of a game show wherein a player may keep a known prize or trade the awarded prize for one of a number of unknown awards which are hidden from view. As stated in the Office Action, during the game show, a contestant is offered multiple award offers, wherein the contestant is given several chances to trade in the award item in exchange for another item. The contestant is allowed to keep their winnings or give up everything already won for a spot in the Big Deal of the Day. The Big Deal of the Day allows the player to receive an award, which is greater or less in value than the initial offer. LMD does not disclose a first potential award offer formed from a first quantity of first values (wherein the first quantity is greater than one) and a second potential award offer formed from a quantity number of second values. Moreover, LMD does not disclose that the first quantity is, on average, greater than the second quantity, and the second values are, on average, greater than the first values.

Pau discloses a gaming machine wherein on the occurrence of a predefined event, a player is offered a choice of two or more different prize sets. Each set contains a plurality of prize outcomes. One prize is randomly drawn from each prize set selected by the player. The drawn prize(s) are provided to the player. Pau does not disclose a first potential award offer formed from a first quantity of first values (wherein the first quantity is greater than one) and a second potential award offer formed from a quantity number of second values. Moreover, Pau does not disclose that the first quantity is, on average, greater than the second quantity.

The Office Action acknowledges that Yoseloff in view of LMD and Pau does not disclose a first potential award offer formed from a first quantity of first values, the first quantity is greater than one, a second potential award offer formed from a second quantity of second values, wherein the first quantity is, on average, greater than the second quantity and the second values are, on average, greater than the first values.

Moreover, the Office Action acknowledges that Yoseloff in view of LMD and Pau does not disclose the quantity of values used to form the first award offer is selected from a first range of quantities having a greater upper end than a second range of quantities employed to select the quantity of values used to form the second award offer.

The Office Action states that:

[n]evertheless, the award offers formed from various quantity of values with various average values is a design variation of Pau's game scheme in which each award offer has the equivalent ratio of a winning outcome to a winning amount, wherein each award offer has a different range of award values, with different probability of obtaining the award. It is well known in the art to weigh values within ranges in order to have certain values chosen more than others and have awards to have approximately the same expected value. This is an important aspect of casino management used to control the odds in which awards or other features are present. Yoseloff in view of LMD demonstrate this by providing various games with different winning combinations, which further provides different winning awards; each with approximately the same expected value (Yoseloff, col. 1: 46-65). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify Yoseloff in view of LMD and Pau, gaming device and have a first potential award offer formed from a first quantity of first values, the first quantity is greater than one, a second potential award offer formed from a second quantity of second values, wherein the first quantity is, on average, greater than the second quantity, and the second values are, on average, greater than the first values; and the quantity of values used to form the first award offer is selected from a first range of quantities having a greater upper end than a second range of quantities employed to select the quantity of values used to form the second award offer in order to offer the possibility to win from a wide range of awards, and control the odds of the awards.

Applicants respectfully disagree with this reasoning. It is improper for the Office Action to acknowledge that the combination of references relied on does not disclose one or more of the claimed elements and then simply state that these claimed elements are a design variation. In this case, after combining three separate references and acknowledging that these references still fail to disclose (i) a first potential award offer formed from a first quantity of first values, the first quantity is greater than one, and (ii) a second potential award offer formed from a second quantity of second values, wherein the first quantity is, on average, greater than the second quantity and the second values are, on average, greater than the first values, the Office Action incorrectly attributed (i) a first potential award offer formed from a first quantity of first values, the first quantity is

greater than one, and (ii) a second potential award offer formed from a second quantity of second values, wherein the first quantity is, on average, greater than the second quantity and the second values are, on average, greater than the first values as a design choice. Without providing any reference which teaches, discloses or suggests these claimed elements, any conclusions that such claimed elements are a design variation are impermissible.

Applicants further submit that the Office Action improperly relies on hindsight reasoning as a justification for this obviousness rejection. Obviousness cannot be based on the hindsight combination of components selectively culled from prior art to fit the parameters of the claimed invention. When the Examiner fails to explain how the skilled artisan would have been specifically motivated by the prior art to make the claimed combination, the court infers that the obviousness determination has been made in hindsight, which is improper. That is, even if all its limitations could be found in the total set of elements contained in the prior art references, a claimed invention would not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention. An Office Action cannot pick and choose among individual parts of assorted prior art references as a mosaic to recreate a facsimile of the claimed invention. The notion that claims can be deemed obvious merely upon finding similar elements in separate prior parts would necessarily destroy virtually all patents and defeat the congressional purpose in enacting Title 35. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to form the claimed invention.

In this case, the Office Action improperly used hindsight reasoning by stating that the elements of (i) a first potential award offer formed from a first quantity of first values, the first quantity is greater than one, and (ii) a second potential award offer formed from a second quantity of second values, wherein the first quantity is, on average, greater than the second quantity and the second values are, on average, greater than the first values are not disclosed in Yoseloff, LMD or Pau, but still concluded that these elements are merely a design variation. The Office Action is improperly picking and choosing individual elements from two separate gaming device patents and one game

show reference and then filling in the missing elements as a "design variation" to form the gaming devices of independent Claims 1, 20, 36 and 69. Such hindsight reconstruction of independent Claims 1, 20, 36 and 69 is an improper basis for this obviousness rejection. Moreover, there is certainly no teaching, suggestion or motivation for: (1) starting with Yoseloff, (2) then modifying it with LMD, (3) then taking the LMD - Yoseloff combination and further modifying it with Pau, and (4) then taking the Pau -LMD- Yoseloff combination and further modifying it with design choice. Accordingly, the rejections of independent Claims 1, 20, 36 and 69 (and dependent Claims 2 to 13, 15 to 19, 21 to 29, 31 to 35, 37 to 41, and 43 to 45 which depend directly or indirectly from independent Claims 1, 20, 36 and 69) should be withdrawn.

Regarding Independent Claims 46 and 57, Applicants respectfully submit that neither Yoseloff, LMD or Pau individually, nor the gaming device resulting from the combination of Yoseloff, LMD and Pau disclose, teach or suggest determining the greatest/highest of the potential award offers and offering the determined greatest/highest of the potential award offers to the player as an initial offer. That is, while the prize award in one of the doors of Yoseloff may be greater than the prize award of another door, neither Yoseloff (nor LMD or Pau) disclose, teach or suggest determining which of the prize awards is greater and offering the determined greater prize award to the player. On the other hand, the gaming devices of independent Claims 46 and 57 each generally include, amongst other elements, determining the greatest/highest of the potential award offers and offering the determined greatest/highest of the potential award offers to the player as an initial offer.

In response to this reasoning, the Office Action states that:

[I]n order to receive the "third award offer" or the deal of the day in LMD, the player has already obtained the greater award as an initial offer. The initial award offer is used as a wager to receive the "third award offer." Therefore, Yoseloff in view of LMD and Pau, teaches determining the greatest/highest of the potential award offers as an initial offer, in order to wager for the third award offer.

Applicants respectfully disagree and submit that LMD (or Yoseloff or Pau) does not disclose picking a greater award offer of at least two award offers to provide to the player as the initial offer before any offers are presented to the player. On the other

hand, the gaming devices of independent Claims 46 and 57 each generally include, amongst other elements, determining the greatest/highest of the potential award offers and offering the determined greatest/highest of the potential award offers to the player as an initial offer.

Independent Claim 70 is directed to a method of operating a gaming device including, amongst other elements, forming different groups of values and forming a first offer by sequentially determining in the groups whether or not to include one of more values from the groups in the first offer until determining in each group not to include one of the values in the group. Applicants respectfully submit that neither Yoseloff, LMD or Pau individually, nor the gaming device resulting from the combination of Yoseloff, LMD and Pau teach, disclose or suggest forming different groups of values and forming a first offer by sequentially determining in the groups whether or not to include one of more values from the groups in the first offer until determining in each group not to include one of the values in the group. On the other hand, the method of operating a gaming device of independent Claim 70 includes forming different groups of values and forming a first offer by sequentially determining in the groups whether or not to include one of more values from the groups in the first offer until determining in each group not to include one of the values in the group.

Accordingly, for these reasons, Applicants respectfully submit that independent Claims 46, 57 and 70 are patentably distinguished over Yoseloff, LMD and Pau and in condition for allowance.

Claims 47 to 50, 52 to 56, 58 to 62, 64 to 68 and 71 to 78 depend directly or indirectly from independent Claims 46, 57 and 70, are also allowable for the reasons given with respect to Claims 46, 57 and 70 and because of the additional features recited in these claims.

The Office Action rejected Claims 13 to 15, 29 to 31, 41 to 43, 50 to 52, 62 to 64, 78 to 79 under 35 U.S.C. §103(a) as being unpatentable over Yoseloff in view of LMD, in view of Pau and in further view of U.S. Patent No. 5,816,918 to Kelly et al. ("Kelly").

As stated in the Office Action, Kelly discloses a gaming device connected to a network and the internet. The Office Action concludes that it would have been obvious

to one skilled in the art at the time the invention was made to modify Yoseloff's and LMD's gaming device and control the gaming device through a data network and the internet, in order to allow players to play from a remote server, thus providing more flexibility when updating and monitoring the game.

Applicants respectfully submit that regardless of it would have been obvious to modify Yoseloff, LMD and Pau to include the network of Kelly, neither Yoseloff, LMD, Pau or Kelly individually, nor the gaming device resulting from the combination of Yoseloff, LMD, Pau and Kelly teach, disclose or suggest a first one of the potential award offers being formed from a first quantity of first values and a second one of the potential award offers being formed from a second quantity of second values, wherein the first quantity is, on average, greater than the second quantity. On the other hand, the gaming devices of Claims 13 to 15, 29 to 31 and 41 to 43 each include, amongst other elements, a first one of the potential award offers being formed from a first quantity of first values and a second one of the potential award offers being formed from a second quantity of second values, wherein the first quantity is, on average, greater than the second quantity.

Applicants also respectfully submit that regardless of it would have been obvious to modify Yoseloff, LMD and Pau to include the network of Kelly, neither Yoseloff, LMD, Pau or Kelly individually, nor the gaming device resulting from the combination of Yoseloff, LMD, Pau and Kelly teach, disclose or suggest determining the greatest/highest of the potential award offers and offering the determined greatest/highest of the potential award offers to the player as an initial offer. On the other hand, the gaming devices of Claims 13 to 15, 29 to 31, 50 to 52 and 62 to 64 each generally include determining the greatest/highest of the potential award offers and offering the determined greatest/highest of the potential award offers to the player as an initial offer.

Moreover, Applicants respectfully submit that regardless of it would have been obvious to modify Yoseloff, LMD and Pau to include the network of Kelly, neither Yoseloff, LMD, Pau or Kelly individually, nor the method of operating a gaming device resulting from the combination of Yoseloff, LMD, Pau and Kelly teach, disclose or

suggest forming different groups of values and forming a first offer by sequentially determining in the groups whether or not to include one of more values from the groups in the first offer until determining in each group not to include one of the values in the group. On the other hand, the methods of operating a gaming device of Claims 78 and 79 includes forming different groups of values and forming a first offer by sequentially determining in the groups whether or not to include one of more values from the groups in the first offer until determining in each group not to include one of the values in the group. Accordingly, for these reasons, Applicants respectfully submits that Claims 13 to 15, 29 to 31, 41 to 43, 50 to 52, 62 to 64, 78 to 79 are patentably distinguished over Yoseloff, LMD, Pau and Kelly and in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY



Adam H. Masia
Reg. No. 35602
Customer No. 29159

Dated: May 7, 2007